



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,670	08/31/2001	Brad Pivar	7207-211	1117

26263 7590 01/04/2007
SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
----------	--------------

2165

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/943,670	PIVAR ET AL.	
	Examiner	Art Unit	
	Neveen Abel-Jalil	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 September 2006.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-7, 9 and 11-24 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 2-7, 9, and 11-24 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-Septmeber-2006 has been entered.
2. Claims 2-7, 9, and 11-24 are pending.

Information Disclosure Statement

3. Applicant's Information Disclosure Statement filed on 9/12/2006 have been received, and entered into the record.

However, It is impractical for the examiner to review the references thoroughly with the number of references cited in this case. By initializing each of the cited references on the accompanying 1449 forms, the examiner is merely acknowledging the submission of the cited references and merely indicating that only a cursory review has been made of the cited references.

MPEP § 2004.13 states:

It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. See *Penn Yan Boats, Inc. v. Sea Lark Boats, Inc.*, 359 F. Supp. 948, 175 USPQ 260 (S.D. Fla. 1972), aff'd, 479 F.2d 1338, 178 USPQ 577 (5th Cir. 1973), cert. denied, 414 U.S. 874 (1974). But cf. *Molins PLC v. Textron Inc.*, 48 F.3d 1172, 33 USPQ2d 1823 (Fed. Cir. 1995).

Further, it should be noted that an applicant's duty of disclosure of material and information is not satisfied by presenting a patent examiner with "a mountain of largely irrelevant [material] from which he is presumed to have been able,

with his experience and with adequate time, to have found the critical [material]. It ignores the real world conditions under which examiners work." Rohm & Haas Co. v. Crystal Chemical co., 722 F.2d 1556, 1573 [220 USPQ 289] (Fed. Cir. 1983), cert. Denied, 469 U.S. 851 (1984). Patent applicant has a duty not just to disclose pertinent prior art references but to make a disclosure in such a way as not to "bury" it within other disclosures of less relevant prior art; see Golden Valley Microwave Foods Inc. v. Weaver Popcorn Co. Inc., 24 USPQ2d 1801 (N.D. Ind. 1992); Molins PLC v. Textron Inc., 26 USPQ2d 1889, at 1899 (D.Del 1992); Penn Yan Boats, Inc. v. Sea Lark Boats, Inc. et al., 175 USPQ 260, at 272 (S.D. Fl. 1972).

4. The applicant is respectfully requested to follow the procedures above for the Information disclosure statement filed 9/12/2006. The Information Disclosure Statement has not been included with this office action but will be considered when it conform with the above requirement.

Claim Objections

5. Claims 2-7, 9, and 11-24 are objected to because of the following informalities:

Claims 3, and 13 recite an "if" statement that suggests optionally, passive recitation. If the Applicant intended to have the remaining limitations after the "if" statement to be considered fully and given complete patentable weight. The "if" recitation should be changed to recite more firm and definite language (i.e. when or wherein). Since "if" statement is optional, the remaining limitation does not necessarily have to happen (i.e. the presentation of document). Appropriate correction is required.

Claim 9, lines 5-6, and 16-17, recite “used” which implies intended use never actually having to take place, the word “used” should be deleted. Claim 18 has similar language, which too needs correction.

Dependent claims 19-24 that depends on Independent claim 18 should start with “The computer readable program code according to claim 18” instead of the current recitation.

It appears, as though the “request” claimed is an electronic request. The claims should be clarified by including such recitation.

Claim 11, line 7, recite, “operative with” which suggest capability not a functionality, the recitation should be amended to “configured to”.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9, and 18 recite the limitation "the time of submission" in lines 12, and 23. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 2-7, 9, and 11-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Slater et al. (U.S. Patent No. 6,796,489).

As to claims 9, 11, and Slater et al. discloses a system for interactive processing of a document comprising:

a storage device (See Figure 1, shows storage devices);

a processor connected to the storage device and to a first and second user on a computer network (See Figure 1, shows a computer connected to wide area network);

a timing device connected to the processor;

the storage device storing a program to control the processor (See Figure 1, shows storage devices, 21, processing unit); and

the processor operative with the program to:

send at least one request determined from a selected document to a first user at a first location on a computer network (Sere column 9, lines 25-40);

receive at least one response to the at least one request from the first user (See column 9, lines 25-40);

write information obtained from the at least one response from the first user to at least one digital file (See column 9, lines 45-53);

determine a first time stamp from the timing device corresponding to the receipt of the at least one response to the at least one request from the first user (See column 8, lines 24-50);

perform a first digital signature routine on the at least one digital file to obtain an original digital signature (See column 8, lines 24-50);

record the first time stamp and first original digital signature associated with the at least one digital file in a database (See column 8, lines 24-50);

send at least one request determined from the selected document to a second user at a second location on a computer network (See column 10, lines 34-50);

receive at least one response to the at least one request from the second user (See column 3, lines 13-16);

write information obtained from the at least one response from the second user to at least one digital file (See column 3, lines 13-16);

determine a second timestamp from the timing device corresponding to the receipt of the at least one response to the at least one request from the second user (See column 13, lines 30-37, all digital signatures are stored with timestamp);

perform a second digital signature routine on the at least one digital file to obtain an original signature (See column 10, lines 51-59); and

record the second timestamp and second original digital signature associated with the at least one digital file in the database (See Figure 3A, shows both signature on the document stored as a record in Database).

As to claims 2, 12, and 19, Slater et al. discloses wherein the computer network is the Internet (See column 6, line 57).

As to claims 3, 13, and 20, Slater et al. discloses further comprising to determine whether the at least one response to the least one request from the first user is valid and sending at least one additional request to the first user for additional information when the at least one response from the first user is invalid (See column 3, lines 13-16, wherein “valid” reads on “verification”).

As to claims 4, 14, and 21, Slater et al. discloses further comprising to determine whether the at least one response to the least one request from the second user is valid and sending at least one additional request to the second user for additional information when the at least one response from the second user is invalid (See column 16, lines 25-59, wherein if document is not valid or completed, more information can be requested from any user for recordation).

As to claims 5, 15, and 22, Slater et al. discloses further comprising to perform a routine determined from the selected document to provide feedback to the first user, the feedback determined in part by the at least one response to the at least one request received from the first user (See column 10, lines 34-50).

As to claims 6-7, 16-17, and 23-24, Slater et al. discloses further comprising to perform a routine determined from the selected document to provide feedback to the second user, the feedback determined in part by the at least one response to the at least one request received from the second user (See column 16, lines 25-59, wherein if document is not valid or completed, more information can be requested from any user for recordation).

Response to Arguments

10. Applicant's arguments with respect to claims 2-7, 9, and 11-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pallante et al. (U.S. Pub. No. 2003/0028495) teaches certification of submission of document to a 3rd. party.

Teppler et al. (U.S. Patent No. 6,792,536) teaches smart card system for providing dates on digital files.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5: 30PM EST.

Art Unit: 2165

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Neveen Abel-Jalil
December 26, 2006